

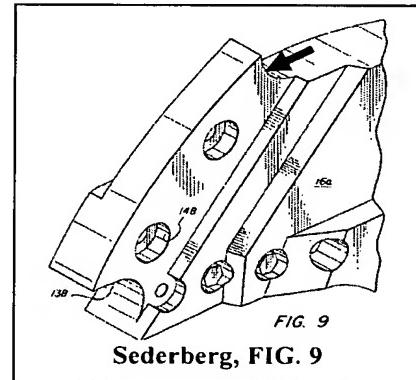
REMARKS

Claims 1-23 and 25-37 were pending, claims 26-37 of which were withdrawn. In this response, claim 14 is amended, claims 32-37 are cancelled without prejudice or disclaimer, and new claims 38-41 are added. New claims 38-41 are supported at least by originally filed claim 1 and FIGS. 8a, 8b, and 10. Applicants request reconsideration and allowance of pending claims 1-23, 25, and 38-41 in view of the above amendments and following remarks.

Applicants appreciate the Examiner's indication that claims 12, 13, 21, and 22 contain patentable subject matter.

Claims 23 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,992,023 ("Sederberg"). Applicants respectfully traverse this rejection. Claim 23 recites, among other recitations, that "said cut-out or notch has contours that are the same as a portion of contours of said pocket or cavity and wherein said recessed seating surface has a geometric configuration which permits an insert member to be seated thereagainst in multiple positions, with one laterally protruding tip portion of the insert member seating within said pocket or cavity and another, generally identically configured, laterally protruding tip portion of the insert member engaging against surfaces of said cut-out or notch in each of said multiple positions." The "Cut-out" and "Pocket" identified by the Examiner on page 3 of the Office Action would not permit "an insert member to be seated thereagainst in multiple positions, with one laterally protruding tip portion of the insert member seating within said pocket or cavity and another, generally identically configured, laterally protruding tip portion of the insert member engaging against surfaces of said cut-out or notch in each of said multiple positions."

Moreover, to the extent that the Examiner might instead assert that the concavely contoured upper surface of the jaw identified to the right is a "Pocket," Applicants traverse the rejection. Claim 23 recites, among other recitations, "at least one bore or depression, other than said pocket or cavity, extending laterally from said recessed seating surface and configured to receive therein a support boss extending laterally from the insert member or a support dowel when the insert member is in said multiple positions." Sederberg's depressions 148 are disposed asymmetrically relative to a point half-way between the "Cut-out" and the proposed "Pocket." Such non-symmetrical positioning of the depressions 148 would prevent the insert member with a support boss or dowel from being seated in "multiple positions," as recited in claim 23. Accordingly,



Applicants submit that Sederberg fails to disclose or suggest the combination of recitations in claim 23, and respectfully request the withdrawal of the anticipation rejection of claim 23, as well as its dependent claim 25, which is allowable at least because it depends from patentable claim 23.

Claims 1-11 and 14-20 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,339,535 (“Morikawa”) in view of Sederberg. Applicants respectfully traverse this rejection for at least the following reasons.

Claims 1, 5, and 14 recite combinations that include, among other recitations, “a metal tip portion disposed at each of said two ends, each said tip portion protruding laterally with respect to said central region in the direction of a first side of said” “body”(claims 1 and 5) or “insert body”(claim 14). Morikawa and Sederberg do not disclose or suggest, either alone, or in combination, such a combination of recitations. Applicants therefore respectfully request the withdrawal of the anticipation rejection of claims 1 and 5, as well as dependent claims 2-4, 6-11, and 15-20, which are allowable at least because they depend from patentable independent claims 1, 5, and 14, respectively.

Applicants traverse the rejection of dependent claims 7 and 16 for an additional reason. Claim 7 recites, among other recitations, that “the front, nose portion of the movable jaw member has a pocket or cavity extending laterally inwardly from a surface thereof into which the tip portions of the wear plate/piercing tip insert each fit, one of the tip portions being fitted in said pocket or cavity when positioned in a non-operative position.” Claim 16 similarly recites, among other recitations, that “the front, nose portion of the jaw body has a pocket or cavity extending laterally inwardly from a surface thereof into which the tip portions of the wear plate/piercing tip insert each fit, one of the tip portions being fitted in said pocket or cavity when positioned in a non-operative position.” Morikawa and Sederberg do not disclose or suggest, either alone, or in combination, such combinations of recitations. Moreover, it would not have been obvious to incorporate such a pocket or cavity into the movable jaw member or jaw body of Morikawa or Sederberg because the resulting position of such a pocket or cavity for the non-operatively positioned tip portion would weaken the corresponding portions of the movable jaw identified below:

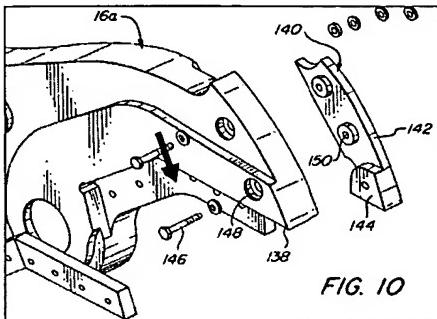
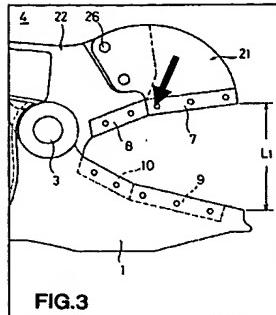


FIG. 10

Sederberg, FIG. 10



Morikawa, FIG. 3

Consequently, Morikawa and Sederberg do not disclose or suggest, either alone, or in combination, the combination of recitations in claims 7 or 16, and Applicants respectfully request the withdrawal of the obviousness rejection of claims 7 and 16.

Applicants traverse the rejection of dependent claims 8 and 17 for an additional reason. Morikawa and Sederberg do not disclose or suggest, either alone, or in combination, a combination of recitations including, among others, that “the pocket or cavity has contours that match surface contours of the tip portions,” as recited in claims 8 and 17. Accordingly, Applicants respectfully request the withdrawal of the obviousness rejection of claims 8 and 17.

Applicants traverse the rejection of claims 10 and 19 for an additional reason. Claim 10 recites, among other recitations, that “said wear plate/piercing tip insert further comprises at least one boss or dowel that is located between said metal tip portions and that extends laterally from said central region in the direction of the first side of said body and wherein the front, nose portion of the movable jaw has a depression extending laterally inwardly from a surface thereof that matches surface contours of said at least one boss or dowel, said at least one boss or dowel fitting within said depression.” Similarly, claim 19 recites, among other recitations, that “said wear plate/piercing tip insert further comprises a boss that is located between said metal tip portions and that extends laterally from said central region in the direction of the first side of said body and wherein the front, nose portion of said jaw member has a depression extending laterally inwardly from a surface thereof that matches surface contours of said boss, said boss fitting within said depression.” The Examiner asserts that it would have been obvious to incorporate the boss 150 and depression 148 shown in FIG. 9 of Sederberg into the tip 7 of Morikawa. However, such a combination would prevent the resulting tip from being indexable, as recited in base independent claims 5 and 14. Specifically, as shown in FIG. 9 of Sederberg, the depressions 148 and bosses 150 are not symmetrically disposed relative to a “pivot axis passing centrally through said wear plate/piercing tip insert” (see claims 5 and 14).

Accordingly, the tip resulting from the incorporation of the depression(s) 148 and boss(es) 150

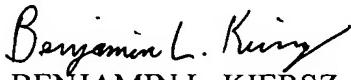
into the Morikawa device would not be indexable because the boss(es) 150 and depression(s) 148 would not align upon rotation of the tip. Accordingly, even if combined, Morikawa and Sederberg fail to disclose or suggest the combinations recited in claims 10 and 19, and Applicants respectfully request the withdrawal of the obviousness rejection of claims 10 and 19.

Applicants traverse the rejection of dependent claim 4 for an additional reason. Claim 4 recites an indexable wear plate/piercing tip insert that includes, among other recitations, “at least one boss or dowel that is located between said metal tip portions and that extends laterally from said central region in the direction of the first side of said body.” The cutting edge insert 7 disclosed in Morikawa includes no such boss or dowel. *See* Morikawa, FIGS. 1-5. Similarly, the cutter blade 116 disclosed in Sederberg includes no such boss or dowel. Applicants note that, as discussed above, a discrete nose member 140 disclosed in Sederberg does include a boss or dowel. *See* Sederberg, FIG. 10. However, for the reasons discussed above with respect to Claims 10 and 19, it would not have been obvious to incorporate such a boss or dowel into the insert 7 of Morikawa or the cutter blade 116 of Sederberg. Consequently, Morikawa and Sederberg do not disclose or suggest, either alone, or in combination, the combination of recitations in claim 4, and Applicants respectfully request the withdrawal of the obviousness rejection of claim 4.

New claims 38-41 further distinguish one or more embodiments of the present invention from the cited reference. For example, with respect to claim 38, the cited references do not disclose or suggest a combination reciting, among other among recitations, that “the at least one bore or depression comprises a first bore or depression that is equally spaced from the cut-out or notch and from the pocket or cavity.” With respect to claim 39, the cited references do not disclose or suggest a combination reciting, among other among recitations, that “the at least one bore or depression comprises a first bore or depression and a second bore or depression, wherein the first bore or depression is spaced from the cut-out or notch by the same distance that the second bore or depression is spaced from the pocket or cavity.” With respect to claim 40, the cited references do not disclose or suggest a combination reciting, among other recitations, that “the at least one boss or dowel comprises a first boss or dowel that is disposed at the pivot axis.” With respect to claim 41, the cited references do not disclose or suggest a combination reciting, among other recitations, that “the at least one boss or dowel comprises a first boss or dowel and a second boss or dowel, wherein the first boss or dowel and the second boss or dowel are spaced equal distances away from the pivot axis.”

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Respectfully submitted,
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